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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

TAYLOR II, JAMES W

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ATTACHMENT TO ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed 3/13/2009 have been fully considered but they are not persuasive. Specifically, the applicant argues: (i) the addition of mica or micaceous material is not disclosed in the primer of Hartman; (ii) zinc sulphide has been selected out of an exhaustive list without motivation; (iii) the amount of zinc sulphide has been reduced well below the limits set by Hartman; and (iv) one of ordinary skill in the art would not use carbonaceous material in the present invention, and the applicant implies that using such carbonaceous materials will prevent a composition from being laser markable.
2. Regarding argument (i), although the examiner concedes that the office action cited mica in a topcoat as opposed to the primer, the primer can comprise mica (c. 2, ll. 34-35).
3. KRS rationale (e) is "Obvious to try" (i.e., choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success) Thus, under KSR rationale (e), it would have been obvious for one of ordinary skill in the art at the time of the invention to try using mica and zinc sulphide as pigments in Hartman, thereby controlling the aesthetic appearance of the primer.

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4. Regarding argument (ii), the examiner submits the mere fact that the reference discloses the pigment in a list of useable pigments is the motivation under KSR rationale (e).

5. Regarding argument (iii), the applicant has misinterpreted the argument that the examiner was making on paragraph 6 of the office action mailed 1/27/2009. The examiner was not proposing that the amount of light and/or white pigment was reduced below the limits disclosed by Hartman. The examiner was suggesting that a mixture of pigments could be used, comprising at least zinc sulfide and white component, and although not explicitly stated in this paragraph, it can be inferred mica would be present as well. The examiner then argued that the reference was silent to how much of each component is present, independently. However, given that we are dealing with pigments, the amount of each pigment present will determine the aesthetic characteristics (i.e., hue and saturation) of the resulting primer.

6. Further, contrary to the applicants allegations on pages 2-3 of the remarks filed 3/13/2009, the "primer" does not have to be coated as it can be used as a finishing coating over a primer itself (c. 1, ll. 60-63) or without an overcoat, as implied by the permissible language used in Hartman (i.e., "may," c. 5, ll. 10-20). As such, one of ordinary skill in the art would recognize that the primer could be "a top coat," and thus aesthetics would be desirable.

7. In light of the above, the examiner maintains that it would have been obvious to optimize the amount of each of the pigments independently of each other (i.e., the ratio

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of components). There would clearly be an optimized formulation where zinc sulfide is present in an amount between 0.05 to 3 weight percent, but all light and/or white pigments are in the range disclosed by Hartman.

8. Regarding argument (iv), first there is nothing of record to the examiner's knowledge to suggest that carbonaceous fibers would prevent a composition containing it from being laser markable. This is especially true considering that etching lasers will effectively mark anything, and thus "laser markable" is not generally limiting without more specific information (such as laser intensity and frequency). Second, even if carbon would prevent the composition from serving its intended purpose, the present claims are claimed with open language (i.e., "comprising"). Using hybrid language (i.e., "consisting essentially of") or closed language (i.e., "consisting of") would be necessary to advance such an argument.

/James W Taylor II/
Examiner, Art Unit 1796

James W. Taylor II

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796